

REMARKS

Claims 1 to 15 are now pending.

Claims 1, 5 and 8 have been amended to include features recited in claim 13, and claim 13 has been amended to include features recited in claims 1, 5 and 8. Thus, no new matter has been added and the Examiner is respectfully requested to enter the amendments. Moreover, since the amendments include subject matter already considered by the Examiner, the amendments do not require further consideration and search, and should thus be entered in response to the Final Office Action.

Applicants respectfully request that the Examiner acknowledge the claim to priority and receipt of the priority document in the next office communication.

Reconsideration of the present application is respectfully requested.

Claims 1, 4, 5, and 8 to 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,226,747 ("Larson") in view of U.S. Patent No. 5,109,413 ("Comerford").

Claim 1 as presented relates to a device for preventing pirated copies of computer programs for use with a computer, the device including input and output devices for bidirectional data exchange with the computer, a first memory element containing a data file that is transferrable to the computer via the output device, and a second memory element into which data is writable by the input device, *the data including an identifier uniquely identifying the computer*, and further provides that the data file transferrable to the computer includes a key uniquely identifying a licensed copy of the computer program. Additionally, claim 1 as presented provides that the device is configured to erase the key from the first memory element upon a successful transfer of the data file so that a subsequent attempt to transfer the data file to another computer does not result in a transfer of the key to the other computer unless the key has been transferred back to the device from the computer which received the key.

In this regard, the claimed subject matter may be exemplified, for example, using a dongle, in which before delivery of the dongle, the dongle is programmed with a unique key. If the program is installed, the key is removed from the dongle and hidden on the target computer, and a unique identifier of the computer is written into the dongle. With the key now residing on the computer, the program is executable on the target computer without the need of the dongle being attached, and the dongle may not be used to install an additional instance of the program on another computer. Should it be required to install the program on a different computer, the unique identifier of the computer is verified and the

hidden key on the computer is transmitted back from the computer to the dongle so that the program is no longer executable on this computer and the dongle may be used to install the program on another computer.

As admitted on page 3 of the Final Office Action, "Larson" does not disclose or suggest a device configured to erase the key from the first memory element upon a successful transfer of the data file so that a subsequent attempt to transfer the data file to another computer does not result in a transfer of the key to the other computer unless the key has been transferred back to the device from the computer which received the key. Instead, the Final Office Action asserts on page 3 that col. 7, lines 26 to 41, col. 17, lines 31 to 57, and Figure 1 item 20, of the "Comerford" reference disclose these features. However, such portions of the "Comerford" reference merely refer to a method of transferring a right to execute from a source coprocessor to a sink coprocessor, in which the right to execute is transferred from the source coprocessor to the sink coprocessor, and then erased from the source coprocessor when the sink coprocessor indicates that the right to execute has been safely received. Here, there is no reciprocal transfer of a unique identifier of the sink processor from the sink processor to the source processor to ensure that a subsequent attempt to transfer the right to execute back the source processor can only occur from the sink processor.

By contrast, the presently claimed subject matter provides a unique point-to-point connection between the dongle and the target computer by transferring and removing a unique key from the dongle to the computer, and by transferring a unique computer identifier from the computer to the dongle. It is therefore respectfully submitted that "Larson" and "Comerford", either alone or combined, do not describe this unique point-to-point connection, in which a unique key is transferred and removed from the dongle to the computer, and a unique identifier identifying the computer is transferred from the computer to the dongle.

It is therefore respectfully submitted that claim 1 as presented is allowable for at least these reasons.

Claims 4, 9 and 10 depend from claim 1 as presented, and are therefore allowable for at least the same reasons as claim 1 as presented.

Claims 5 and 13 as presented include features like those of claim 1 as presented, and are therefore allowable for essentially the same reasons as claim 1 as presented.

Claim 14 depends from claim 13, and is therefore allowable for at least the same reasons as claim 13.

In sum, it is respectfully submitted that claims 1, 4, 5, and 8 to 14, as presented, are allowable for at least the reasons discussed above. Withdrawal of these rejections is therefore respectfully requested.

As to paragraph eleven (13) of the Office Action, claims 2 and 3 were rejected as obvious under 35 U.S.C. § 103(a) over "Larson" and "Comerford" in view of Pavlin et al., U.S. Patent No. 6,523,119.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

With respect to the obviousness rejections of claims 2 and 3 as unpatentable over "Larson" and "Comerford" in view of U.S. Patent No. 6,523,119 ("Pavlin"), it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary "Pavlin" reference does not cure the critical deficiencies of the "Larson" and "Comerford" references (as explained above) with respect to claim 1 as presented, from which claims 2 and 3 ultimately depend. Indeed, the Office Action does not assert that "Pavlin" cures the deficiencies of "Larson" and "Comerford" as applied against claim 1 as presented. It is therefore respectfully submitted that claims 2 and 3 are allowable for at least the same reasons that claim 1 as presented is allowable. Accordingly, withdrawal of the obviousness rejections of claims 2 and 3 is respectfully requested.

As to paragraph fourteen (16), claim 6 was rejected under 35 U.S.C. § 103(a) as unpatentable over "Larson" and "Comerford" in view of U.S. Patent No. 6,434,535 ("Kupka") and further in view of U.S. Patent No. 6,411,941 ("Mullor").

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary "Kupka" and "Mullor" references do not cure the critical deficiencies of the "Larson" and "Comerford" references (as explained above) with respect to claim 5 as presented, from which claim 6 depends. Indeed, the Final Office Action does not allege that "Kupka" and "Mullor" cure the deficiencies of "Larson" and "Comerford" as applied against claim 5 as presented. It is therefore respectfully submitted that claim 6 is allowable for at least the same reasons that claim 5 as presented is allowable. Accordingly, withdrawal of the obviousness rejections of claim 6 is respectfully requested.

As to paragraph sixteen (18), claim 7 was rejected under 35 U.S.C. § 103(a) as unpatentable over "Larson" in view of "Comerford."

It is respectfully submitted that even if it were proper to modify "Larson" as suggested (which is not conceded), the proposed modification does not cure the critical deficiencies of the "Larson" and "Comerford" references (as explained above) with respect to claim 5 as presented, from which claim 7 depends. Indeed, the Office Action does not assert that the proposed modification cures the deficiencies of "Larson" as applied against claim 5 as presented. It is therefore respectfully submitted that claim 7 is allowable for at least the same reasons that claim 5 as presented is allowable. Accordingly, withdrawal of the obviousness rejections of claim 7 is respectfully requested.

Finally, as regards paragraph 20, claim 15 was rejected under 35 U.S.C. § 103(a) as unpatentable over "Larson" in view of "Comerford" and further in view of "Kupka" and "Mullor."

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary, "Kupka" and "Mullor" references do not cure the critical deficiencies of the "Larson" and "Comerford" references (as explained above) with respect to claim 13, from which claim 15 ultimately depends. Indeed, the Office Action does not assert that the "Kupka" and "Mullor" references cure the deficiencies of "Larson" and "Comerford" as applied against claim 13. It is therefore respectfully submitted that claim 15 is allowable for at least the same reasons that claim 13 is allowable.

In summary, it is respectfully submitted that all of claims 1 to 15, as presented, of the present application are allowable at least for the foregoing reasons.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn since they have been obviated. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
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